

## **REMARKS**

By this amendment, Applicant amends claims 1, 3, 6, 11, 12, 13, 14, 15, and 30, cancels claim 20 without prejudice or disclaimer, and adds new claims 31-33. Claims are now pending in this application.

In the Office Action<sup>1</sup>, the Examiner took the following actions:

rejected claims 1, 2, and 11 under 35 U.S.C. § 102(b) as being anticipated by Foladare et al. (U.S. Patent No. 5,831,860);

rejected claims 3, 5, and 12 under 35 U.S.C. § 103(a) as being unpatentable over Foladare in view of Franco (U.S. Patent No. 7,257,552) and Roberts et al. (U.S. Patent No. 6,401,078);

rejected claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Foladare in view of Franco and Lopez (U.S. Application Publication No. 2002/0029202);

rejected claims 6-10 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Foladare in view of Lopez;

rejected claims 14, 19, 28, and 30 under 35 U.S.C. § 103(a) as being unpatentable over Foladare in view of Barta et al. (U.S. Patent No. 6,634,5551);

rejected claim 15 under 35 U.S.C. § 103(a) as being unpatentable over Foladare in view of Barta and further in view of Franco;

rejected claims 16-18, 20, and 29 under 35 U.S.C. § 103(a) as being unpatentable over Foladare in view of Barta and further in view of Lopez;

rejected claims 21-25 under 35 U.S.C. § 103(a) as being unpatentable over Foladare in view of Barta and in further view of Kadaba (U.S. Patent No. 6,539,360); and

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<sup>1</sup> The Office Action may contain a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

rejected claims 26 and 27 under 35 U.S.C. § 103(a) as being unpatentable over Foladare in view of Barta and Jones (U.S. Patent Application Publication No. 2003/0233190).

**I. Rejection of Claims 1, 2, and 11 under 35 U.S.C. § 102(b)**

Applicant respectfully traverses the rejection of claims 1, 2, and 11 under 35 U.S.C. § 102(b) as being anticipated by Foladare. To properly anticipate Applicants' claimed invention, the Examiner must demonstrate the presence of each and every element of the claim in issue, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, “[t]he elements must be arranged as required by the claim.” M.P.E.P. § 2131.

Amended independent claim 1 recites a method for changing the delivery point of an item while the item is en route including, among other steps, “notifying, based on the first delivery point, a recipient that the item is en route” and “notifying, based on an identifier of a sender, the sender that the item is en route.”

Foladare discloses that an “addressee [can leave an instruction] . . . for the package carrier to call the addressee, or his representative, and ask if the package should be redirected, and, if so, what should be the new address, if it is not prestored.” Col. 3, lines 31-35. In the Office Action, the Examiner admits that Foladare “fails to explicitly disclose notifying a sender of the item” (emphasis omitted). Office Action at page 3. Accordingly, Foladare cannot disclose or suggest “notifying, based on an identifier of a sender, the sender that the item is en route,” as recited in amended

independent claim 1 (emphasis added). Therefore, claim 1 is not anticipated by Foladare for at least this reason.

Claim 2 depends from claim 1, and independent claim 11, although of a different scope, includes recitations similar to claim 1. For at least the reasons discussed above, claims 2 and 11 are not anticipated by Foladare. Therefore, the Examiner should withdraw the rejection of claims 1, 2, and 11 under 35 U.S.C. § 102(b) as being anticipated by Foladare.

## II. Rejection of Claims 3, 5, and 12 under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 3, 5, and 12 under 35 U.S.C. § 103(a) as being unpatentable over Foladare in view of Franco and Roberts. A *prima facie* case of obviousness has not been established.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See id. “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” M.P.E.P. § 2145. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences

themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

“[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Claim 3 depends from amended independent claim 1. As discussed above, Foladare does not disclose or suggest “notifying, based on the first delivery point, a recipient that the item is en route” **and** “notifying, based on an identifier of a sender, the sender that the item is en route,” as recited in amended independent claim 1. The Office Action alleges that Franco “teaches notifying a sender” and alleges that “simple substitution of one known element for another producing a predictable result renders the claim obvious.” Office Action at pages 3 and 4. However, this is not correct.

According to Franco, “shipping documentation is processed” and “involves sending confirmations of the shipment to the sender, carrier, and receiver, generating shipping schedules, generating applicable billing information, notifying the receiver upon arrival of the parcel at the identified [Order Aggregation Site] OAS 400, notifying the sender upon receipt of the parcel by the receiver, etc.” Col. 63, lines 1-7. However, this does not constitute or suggest notifying both a sender and a receiver that an item is

en route. That is, Franco does not teach or suggest “notifying, based on the first delivery point, a recipient that the item is en route” and “notifying, based on an identifier of a sender, the sender that the item is en route,” as recited in amended independent claim 1 and required by claim 3.

Moreover, the rationale advanced in the Office Action at page 5 that simple substitution of one known element for another producing a predictable result renders the claim obvious is incorrect. As amended, independent claim 1 requires notifying both a sender and a receiver that an item is en route. Accordingly, even if the Office Action’s characterization of the cited references is correct, which Applicant does not concede, Applicant’s claimed combination cannot be obtained by merely substituting notifying a “sender” with notifying a “recipient.”

To reject a claim based on a “simple substitution” rationale, “Office personnel must resolve the *Graham* factual inquiries” and then articulate, among other requirements, “a finding that one of ordinary skill in the art could have substituted one known element for another, and the results of the substitution would have been predictable.” M.P.E.P. § 2143(B). As set forth above, one of ordinary skill in the art would not substitute substituting notifying a “sender” with notifying a “recipient” because the amended claim requires notifying both a sender and a receiver that an item is en route. Moreover, as the amended claim requires notifying both a sender and a recipient, the proposed substitution would additionally fail to produce a predictable result. Consequently, the Office Action’s rationale is improper.

Roberts does not compensate for the deficiencies of Foladare and Franco. That is, Roberts does not teach or suggest “notifying, based on the first delivery point, a

recipient that the item is en route" and "notifying, based on an identifier of a sender, the sender that the item is en route," as recited in amended independent claim 1 and required by claim 3 due to its dependence.

As explained above, the rationale for combining the cited references is improper. Moreover, contrary to the allegations of the Office Action, the elements of the claims are neither taught nor suggested by the cited references. Consequently, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claims. Accordingly, no reason has been clearly articulated as to why the claim would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established and the Examiner should withdraw the rejection of claim 3 under 35 U.S.C. § 103(a)..

Amended independent claim 5 recites a method including, among other steps, "confirming the instruction to deliver the item to the second delivery point by notifying a sender of the second delivery point." Foladare, Franco, and Roberts do not teach or suggest at least this element of amended independent claim 5.

As discussed above, Foladare discloses that an "addressee [can leave an instruction] . . . for the package carrier to call the addressee, or his representative, and ask if the package should be redirected, and, if so, what should be the new address, if it is not prestored." Col. 3, lines 31-35. However, Foladare does not disclose or suggest "**confirming the instruction to deliver the item to the second delivery point by notifying a sender of the second delivery point,**" as recited in amended independent claim 5 (emphasis added).

Neither Franco nor Roberts compensate for the above deficiency of Folandare.

For example, Franco discloses “sending confirmations of the shipment to the sender, carrier, and receiver, generating shipping schedules, generating applicable billing information, notifying the receiver upon arrival of the parcel at the identified [Order Aggregation Site] OAS 400, notifying the sender upon receipt of the parcel by the receiver, etc.” Col. 63, lines 1-7. Roberts discloses “receiving transportation documentation and producing advance loading manifests . . . to optimize load planning and dynamic product shipment and delivery control.” Abstract. However, Franco and Roberts do not disclose or suggest “**confirming the instruction to deliver the item to the second delivery point by notifying a sender** of the second delivery point,” as recited in amended independent claim 5 (emphasis added).

Amended independent claim 12 recites a system for changing the delivery point of an item including a unique identifier while the item is en route, the system including “means for notifying a sender that the item is en route **based on the unique identifier**” and “means for **receiving from a recipient an instruction specifying that the item is to be delivered to a second delivery point, the instruction including the unique identifier**” (emphases added). Folandare, Franco, and Roberts do not teach or suggest at least these elements of amended independent claim 12.

The Office Action admits that Folandare “fails to explicitly disclose notifying a sender of the item; and allowing the sender to specify that the item is to be delivered to the second delivery point” (emphases omitted). Office Action at page 4. However, the Office Action contends that Franco and Roberts compensate for this deficiency of Folandare. This is not correct.

While Franco discloses “notifying the receiver upon arrival of the parcel at the identified [Order Aggregation Site] OAS 400, [and] notifying the sender upon receipt of the parcel by the receiver” (col. 63, lines 1-7)(emphases added), Franco does not disclose or suggest “means for notifying a sender that the item is en route **based on the unique identifier**” and “means for receiving from a recipient an instruction specifying that the item is to be delivered to a **second delivery point, the instruction including the unique identifier,**” as recited in amended independent claim 12 (emphases added). Nor does Roberts teach or suggest at least these elements of independent claim 12.

As explained above, the elements of independent claims 5 and 12 are neither taught nor suggested by the cited references. Moreover, there is no teaching in the references which would motivate one of ordinary skill in the art to modify the disclosures thereof to achieve the claimed combinations. Consequently, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claims. Accordingly, no reason has been clearly articulated as to why the claims would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established and the Examiner should withdraw the rejection of claims 5 and 12 under 35 U.S.C. § 103(a).

### III. Rejection of Claim 4 under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Foladare in view of Franco and Lopez. Claim 4 depends

from claim 1. As discussed above, Foladare and Franco do not teach or suggest “notifying, based on the first delivery point, a recipient that the item is en route” and “notifying, based on an identifier of a sender, the sender that the item is en route,” as recited in amended independent claim 1 and required by claim 4 due to its dependence. Moreover, Lopez does not compensate for the deficiencies of Foladare and Franco.

As explained above, the elements of the claims are neither taught nor suggested by the cited references. Moreover, there is no teaching in the references which would motivate one of ordinary skill in the art to modify the disclosures thereof to achieve the claimed combination. Consequently, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claims. Accordingly, no reason has been clearly articulated as to why the claim would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established and the Examiner should withdraw the rejection of claim 4 under 35 U.S.C. § 103(a).

#### IV. Rejection of claims 6-10 and 13 under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 6-10 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Foladare in view of Lopez.

Amended independent claim 6 recites a method for handling an undeliverable item including, among other steps, “accepting a disposition instruction from the sender, after . . . notifying [the sender that the item is undeliverable]” and “changing a delivery point of the item while the item is en route after accepting the disposition instruction.”

The Office Action admits that Foladare “fails to explicitly disclose notifying the

sender that the item is undeliverable, accepting a disposition instruction from the sender; and handling the item according to the disposition instruction" (emphases omitted). Office Action at page 6. However, the Office Action contends that Lopez compensates for this deficiency of Foladare. This is not correct.

Lopez discloses:

Some of the mailpieces to be processed are to be forwarded to a receiver forwarding address and some are to be returned to the sender. Some sender's will desire to be notified of the forwarding address when a mailpiece has been forwarded. If a mailpiece is returned, a sender is to be informed as to the reason why. Additionally, for some mailpieces that cannot be delivered but are not worth the cost of return postage, the senders nonetheless will want notification of the non-delivery.

Paragraph [0035].

Although Lopez discloses forwarding mailpieces to a receiver forwarding address and returning mailpieces to a sender, Lopez does not teach accepting a disposition instruction after notifying the sender that the item is undeliverable. Moreover, Lopez does not teach changing a delivery point of an item while it is en route after accepting the disposition instruction. That is, Lopez does not teach or suggest "accepting a disposition instruction from the sender, after . . . notifying [the sender that the item is undeliverable]" and "changing a delivery point of the item while the item is en route after accepting the disposition instruction," as recited in amended independent claim 6 (emphases added).

As explained above, the elements of independent claim 6 are neither taught nor suggested by the cited references. Moreover, there is no teaching in the references which would motivate one of ordinary skill in the art to modify the disclosures thereof to achieve the claimed combination. Consequently, the Office Action has neither properly

determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claim. Accordingly, no reason has been clearly articulated as to why the claim would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established and the Examiner should withdraw the rejection of claim 6 under 35 U.S.C. § 103(a).

Claims 7-10 depend from claim 6 and are not obvious in view of the cited references at least due to their dependence. Independent claim 13, although of a different scope, includes recitations similar to claim 6. Accordingly, independent claim 13 is not obvious in view of the cited references for at least the reasons discussed above. Therefore, the Examiner should also withdraw the rejection of claims 7-10 and 13 under 35 U.S.C. § 103(a).

**V. Rejection of Claims 14, 19, 28, and 30 under 35 U.S.C. § 103(a)**

Applicant respectfully traverses the rejection of claims 14, 19, 28, and 30 under 35 U.S.C. § 103(a) as being unpatentable over Foladare in view of Barta.

Amended independent claim 14 recites a method to flexibly deliver an item including, among other things, “conditionally accepting a second delivery point of the item, comprising requesting, from the sender, an approval of the second delivery point.”

The Office Action admits that Foladare “fails to explicitly disclose conditionally accepting a second delivery point” (emphases omitted). Office Action at page 8. However, the Office Action contends that Barta compensates for this deficiency of Foladare. This is not correct.

Barta discloses that a “customer can . . . be told by . . . [a] delivery service that the customer has . . . packages which were previously undelivered” and “the customer could initiate a ‘delivery change’ request, in which the customer could key in a new address.” Col. 7, lines 21-35. Thus, in Barta, the recipient (i.e., the customer) can request a delivery change to have a package delivered to a new address. However, this does not constitute or suggest requesting an approval of a second delivery point from a sender. That is, Barta does not teach or suggest “conditionally accepting a second delivery point of the item, comprising **requesting, from the sender, an approval of the second delivery point,**” as recited in amended independent claim 14 (emphasis added).

As explained above, the elements of independent claim 14 are neither taught nor suggested by the cited references. Moreover, there is no teaching in the references which would motivate one of ordinary skill in the art to modify the disclosures thereof to achieve the claimed combination. Consequently, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claim. Accordingly, no reason has been clearly articulated as to why the claim would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established and the Examiner should withdraw the rejection of claim 14 under 35 U.S.C. § 103(a).

Claims 19 and 28 depend from independent claim 14 and are not obvious in view of the cited references at least due to their dependence. Independent claim 30, although of a different scope, includes recitations similar to claim 14. Accordingly,

independent claim 30 is not obvious in view of the cited references for at least the reasons discussed above. Therefore, the Examiner should also withdraw the rejection of claims 19, 28, and 30 under 35 U.S.C. § 103(a).

**VI. Remaining Rejections under 35 U.S.C. § 103(a)**

Applicant respectfully traverses the rejection of claim 15 under 35 U.S.C. § 103(a) as being unpatentable over Foladare in view of Barta and further in view of Franco; the rejection of claims 16-18, 20, and 29 under 35 U.S.C. § 103(a) as being unpatentable over Foladare in view of Barta and further in view of Lopez; the rejection of claims 21-25 under 35 U.S.C. § 103(a) as being unpatentable over Foladare in view of Barta and Kadaba; and the rejection of claims 26 and 27 under 35 U.S.C. § 103(a) as being unpatentable over Foladare in view of Barta and Jones. The rejection regarding cancelled claim 20 is now moot.

Claims 15-18, 21-27, and 29 depend from independent claim 14. As discussed above, Foladare and Barta do not teach or suggest “conditionally accepting a second delivery point of the item, comprising requesting, from the sender, an approval of the second delivery point,” as recited in amended independent claim 14. Furthermore, Lopez, Kadaba, and Jones do not compensate for the deficiencies of Foladare and Barta.

As explained above, the elements of the claims are neither taught nor suggested by the cited references. Moreover, there is no teaching in the references which would motivate one of ordinary skill in the art to modify the disclosures thereof to achieve the claimed combinations. Consequently, the Office Action has neither properly determined

the scope and content of the prior art nor properly ascertained the differences between the prior art and the claims. Accordingly, no reason has been clearly articulated as to why the claims would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established and the Examiner should withdraw the rejection of claim 15-18, 21-27, and 29 under 35 U.S.C. § 103(a).

## **VII. New Claims 31-33**

New claim 31 depends from independent claim 12 and is allowable at least due to its dependence. New independent claims 32 and 33 recite combinations that are not obvious in view of the cited references.

## **CONCLUSION**

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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